

REQUEST FOR REHEARING UNDER 37 CFR § 41.52(a)(1)
EXPEDITED PROCEDURE
EXAMINING GROUP:1788

32692

Customer Number

Patent
Case No.: 53766US010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: ZOLLER, PANU K.

Application No.: 10/817439

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Title: ROLL STABILIZING RELEASE LINER

REQUEST FOR REHEARING UNDER 37 CFR § 41.52(a)(1)

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December 14, 2010
Date

/Joyce M. Courtney/
Signed by: Joyce M. Courtney

Dear Sir:

This is a Request for Rehearing under 37 CFR 41.52 (a)(1) from the Decision on Appeal issued by the Board of Patent Appeals and Interferences mailed May 31, 2006.

This Request is believed to be timely submitted. It is believed that no fee is due; however, in the event a fee is required; please charge the fee to Deposit Account No. 13-3723.

Brief Summary of the Points Misapprehended

I. The Board's reliance on what is purported "self-evident" is contrary to Supreme Court precedent as set forth in *KSR*.

According to the Board's decision:

The Examiner also finds that "it is self-evident" that Johnson 924 suggests "that a tackifier is a friction enhancing agent, which is result effective in providing desired level of friction to a release material", such that no further evidentiary support is needed from the Examiner (Ans. 10: *see also* Ans. 9; Johnson 924 at col. 4-5). Notably, Appellants do not dispute this finding of the Examiner, as no responsive brief has been filed.

However, as the Supreme Court made clear "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" (*KSR*, 550 U.S. at 1, 82 USPQ2d at 1396 (quoting *In re Kahn* 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)). See, also *In re Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.) Here, the record clearly establishes that the rejection made by the Examiner and endorsed by the Board relies solely on conclusory statements

II. The Board's reliance on the purported equivalency of EAA and EVA is contrary to Federal Circuit Precedent as set forth by *In Re Ruff*.

According to Federal Circuit Law, "it is no longer possible to indulge in a presumption that the members of a Markush group are recognized by anyone to be equivalents except as they 'possess at least one property in common which is mainly responsible for their function in the claimed relationship.'" (*In Re Ruff*, 256 F.2d 590, 599 (CCPA 1958) (citing the 1953 revision of section 706.03(y) of the Manual of Patent Examining Procedure).) However, the Board expressly relies on the mere fact that EAA and EVA are both listed in the same Markush-type

group identified for release materials to maintain that they are equivalents for other, unrelated purposes stating:

(Ans. 7-10). We fully agree with the Examiner that Johnson 924 suggests that since one of its listed release copolymer materials (EAA) may be modified by a tackifier to provide a roll stability layer as needed, that it would have been reasonably expected that another release layer material (that is, EVA) of Johnson 924 would likewise function as a roll stability layer when modified with a tackifier, “absent any evidence that EVA and tackifier are necessarily incompatible” (Ans. 8).

III. The Board’s decision regarding the required amounts of vinyl acetate is contrary to Federal Circuit Precedent as set forth by *In re Antonie*.

According to the Board’s decision:

We find Appellants’ contention that there is no guidance given as to the vinyl acetate content of Johnson 924 unavailing, since it would have been understood by one of ordinary skill in the art that it would have been undesirable for the EVA release material to block with the heat activated layer of Johnson 924. Consequently, we agree with the Examiner that “selecting a workable vinyl acetate content in EVA” would have been within the level of skill in the art (Ans. 10; *see also* Ans. 6).

However, “A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. (*In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). (See MPEP § 2144.05 (II) (B).)) Neither the Examiner nor the Board has provided any evidence or argument that one of ordinary skill in the art would recognize vinyl acetate content as a results effective variable for any purpose.

Arguments in Support of Request for Rehearing

I. The Board's reliance on what is purported "self-evident" is contrary to Supreme Court as set forth in *KSR*, and Federal Circuit Precedent as set forth in *In re Zurko*.

In precedent binding on this Board, the Supreme Court made clear "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" (KSR, 550 U.S. at 1, 82 USPQ2d at 1396 (quoting *In re Kahn* 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).) At this point, the record clearly establishes that the rejection made by the Examiner and endorsed by the Board relies solely on conclusory statements, including the unsupported assertion that a tackifier can be added to any release material to create a friction enhancing layer.

It is beyond dispute that Johnson '924 explicitly teaches only that the specific combination of "ethylene/acrylic acid mixtures containing tackifiers" is a suitable "friction enhancing agent." In fact, throughout the prosecution history, the Examiner has relied solely on cols. 4-5 of Johnson '924. Col. 4, lines 50-66 identifies a group of olefinic homopolymers or copolymers are identified as release layers including ethylene vinyl acetate (EVA) and ethylene acrylic acid (EAA). Friction enhancing agents are then separately described at col. 4, line 67 – col. 5, line 24. Other than their proximity in the specification, neither the Examiner nor the Board has pointed to anything in Johnson '924 that connects these disparate teachings.

Despite being repeatedly notified by the Appellants, with specific citations to the record, that the only friction enhancing agent describe by Johnson '234 was the combination of both "ethylene/acrylic acid mixtures" and "tackifiers," the Examiner has maintained the position that the tackifier alone is a friction enhancing agent. When properly requested to support his basis for ignoring the plain teaching of the reference, the Examiner merely asserted that it was "self-evident." However, the Examiner's assertion that it is "self-evident" is no less conclusory than his statement that it is "obvious." Absent some articulated reasoning with some rational underpinning for support, the Examiner's mere substitution of one conclusory statement for another cannot sustain the pending rejections.

Compelled by the Supreme Court decision in KSR, the pending rejections, which are based solely on conclusory statements, cannot be sustained.

II. The Board's reliance on the purported equivalency of EAA and EVA is contrary to Federal Circuit Precedent as set forth by *In Re Ruff*.

According to Federal Circuit Law, "it is no longer possible to indulge in a presumption that the members of a Markush group are recognized by anyone to be equivalents except as they 'possess at least one property in common which is mainly responsible for their function in the claimed relationship.'" (*In Re Ruff*, 256 F.2d 590, 599 (CCPA 1958) (citing the 1953 revision of section 706.03(y) of the Manual of Patent Examining Procedure).) Despite such a clear expression of binding authority, the Examiner has consistently relied on the mere fact that EAA and EVA are both listed in the same Markush-type group as release materials to assert that they functional equivalents for other, unrelated purposes.

If the Examiner or the Board is proceeding on any basis other than the false presumption that, because both EVA and EAA are members of the same Markush group they must be equivalents in all respects, such a basis has not been articulated. In fact, the Board has explicitly admitted that its decision is based on just such an improper presumption stating:

(Ans. 7-10). We fully agree with the Examiner that Johnson 924 suggests that since one of its listed release copolymer materials (EAA) may be modified by a tackifier to provide a roll stability layer as needed, that it would have been reasonably expected that another release layer material (that is, EVA) of Johnson 924 would likewise function as a roll stability layer when modified with a tackifier, "absent any evidence that EVA and tackifier are necessarily incompatible" (Ans. 8).

Thus, in addition to proceeding contrary to controlling authority, the Board improperly placed the burden on Appellants to prove the Examiners' unsupported assertions are impossible, without first requiring the Examiner to provide some legally sufficient and rational basis for the assertion to which Appellants can respond.

For at least these reasons, the present rejections cannot be sustained

III. The Board's decision regarding the required amounts of vinyl acetate is contrary to Federal Circuit Precedent as set forth by *In re Antonie*.

According to Federal Circuit Law, "A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. (*In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). (See MPEP § 2144.05 (II) (B).)) Proceeding contrary to such controlling authority, the Board affirmed the Examiner stating:

We find Appellants' contention that there is no guidance given as to the vinyl acetate content of Johnson 924 unavailing, since it would have been understood by one of ordinary skill in the art that it would have been undesirable for the EVA release material to block with the heat activated layer of Johnson 924. Consequently, we agree with the Examiner that "selecting a workable vinyl acetate content in EVA" would have been within the level of skill in the art (Ans. 10; *see also* Ans. 6).

However, the Examiner's and, thus, the Board's sole support for this argument is that "since EVA is a copolymer of ethylene monomer and vinyl acetate monomer, the properties of EVA is [sic] inherently related to the ratio of the two monomers" (Examiner's Answer, page 6.) Such an analysis is clearly improper, as completely eviscerates the holding of *In re Antonie*.

The properties of every material and every combination of materials are inherently related to the choice and amounts of materials. This does not mean that selection of the amounts of materials to achieve a given result is obvious. Rather, as required by of *In re Antonie*, the Patent Office must establish that one of ordinary skill in the art would recognize that the vinyl acetate content had a results-effective relationship to an EVA material's blocking behavior relative to a heat activated layer.

Given the Patent Office's failure to provide any evidence or argument that one of ordinary skill in the art would recognize vinyl acetate content as a results effective variable in selecting a material to provide enhanced friction with a heat activated adhesive, the pending rejections cannot be sustained.

Conclusion

Appellants respectfully submit that the requisite criterion for establishing the need for a rehearing has been met; therefore, Appellants respectfully request that this Request for a Rehearing be granted. As the basis for the pending rejections are in direct conflict with controlling legal authority, Appellants further request that the Board issue a decision overturning the final rejections of claims 1-53 and 55.

Respectfully submitted,

December 14, 2010

Date

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